

Remarks

Claims 1-41 are pending in this Application. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Rejection of Claims 1-37 and 40-41 Under 35 U.S.C. § 112, Second Paragraph

Claims 1-37 and 40-41 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1 and 16 have been amended to address this rejection. Thus, the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

Rejection of Claims 1-41 Under 35 U.S.C. § 112, First Paragraph (Written Description)

The Office Action rejects claims 1-41 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. More specifically, the Office Action alleges that the limitation “said at least one anti-slip stud is rotated about the stud center line relative to the jaw fingers from the first stud orientation to a second, predetermined stud orientation, if the first stud orientation differs from the predetermined stud orientation, as said stud is driven through the stud capturing space” is new matter.

The purported new matter has been deleted from claims 1, 16, 38 and 39. Thus, the written description rejection of claims 1-41 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Rejection of Claims 1-41 Under 35 U.S.C. § 112, First Paragraph (Enablement)

The Office Action also rejects claims 1-41 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. The purported non-enabled subject matter has been deleted from claims 1, 16, 38 and 39. Thus, the enablement rejection of claims 1-41 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Rejection of Claims 1-6, 8-22, and 30-41 Under 35 U.S.C. § 103

Claims 1-6, 8-22 and 30-41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 3,385,742 (“Pettersson”) in view of at least one of U.S. Patent Application Publication No. 2002/0050312 (“Ostrovskis”) and Russian Patent No. 2,152,318 (“Russia”). Applicant respectfully traverses this rejection.

The Office Action contends that “[o]ne of ordinary skill in the art would have had a reasonable expectation of success using Pettersson’s stud installation tool to install out of round studs into premade holes.” Applicant disagrees.

Whereas Pettersson’s device includes jaw fingers and is adapted to install studs with round flanges, Ostrovskis’s and Russia’s devices are adapted to install studs with non-round flanges yet both devices employ tube technology that is substantially different from that of Pettersson. Both Ostrovskis and Russia utilize charging tubes that have a cross-sectional profile that corresponds to the shape of the non-round stud flanges to achieve the proper orientation of the studs as they are installed in a tire. Conventional wisdom, including the teachings of Ostrovskis and Russia, therefore teaches against using the type of installation tool disclosed in Pettersson when installing studs having non-round flanges. MPEP § 2145(D)(2), p. 2100-168 (Sept 2007 version of MPEP) states that it is improper to combine references where the references teach away from their combination. Here, the teachings of Ostrovskis and Russia run directly contrary the teachings of Pettersson, and therefore one would not combine Pettersson with Ostrovskis and/or Russia.

Explaining further, Russia states that prior art installation tools, such as FR2438552, are not suitable for installing studs having non-round flanges because such tools do not provide means for orienting a stud in the proper rotational position relative to its longitudinal axis. FR2438552 shows an installation tool having a cylindrical charging tube and does not have any means for turning or otherwise orienting studs relative to their longitudinal axes. (page 4, paragraphs 5-6 of English translation of Russia.) Thus, if such an installation tool is used to install studs having non-round flanges, the studs would be installed in a tire in random orientations. To address this problem, Russia states that the studs must come out of the charging tube already positioned in the predetermined orientation. (page 8, paragraph 3 of English translation of Russia.) Accordingly, Russia provides a charging tube having guide elements, which in the illustrated example comprises a charging tube that has a cross-sectional profile that corresponds to profiles of the studs. Russia further states that such a charging tube in combination with other features of the tool are essential to obtain the required technical result, i.e., orienting the studs in the proper position for installation in a tire. (page 5, paragraphs 2-3 English translation of Russia.)

Similarly, Ostrovskis also discloses an installation tool that requires a charging tube having a cross-sectional profile that corresponds to the shape of the studs. Like Russia, Ostrovskis also states that the use of such a charging tube is essential to achieve the desired orientation for the studs as they are installed in a tire. (paragraph 0043 of Ostrovskis.)

In contrast, Pettersson discloses studs having round flanges and an installation tool that has a charging tube having a circular cross-sectional profile, which is exactly the type of installation tool that Russia and Ostrovskis teach to avoid. Because Russia and Ostrovskis teach against using the type of installation tool disclosed in Pettersson, one of ordinary skill in the art would not have thought it obvious to use Pettersson's installation tool to install the non-round studs disclosed in Russia and Ostrovskis. MPEP § 2145(D)(2). Nor would one of ordinary skill in the art had a reasonable expectation of success of using Pettersson's stud installation tool to install the non-round studs of Russia and Ostrovskis, especially in view of the fact both Russia and Ostrovskis teach that it is essential to use a non-round charging tube that corresponds to the shape of the studs in order to orient the studs in the desired orientation.

Regarding the motivation to combine the teachings of Pettersson with Ostrovskis and Russia, the Office Action further states: "Ostrovskis and Russia motivate one of ordinary skill in the art to use 'non-round' tire studs in Pettersson's process for installing studs in premade holes in a tread. Ostrovskis for example motivates one of ordinary skill in the art to use non-round studs to improve braking and traction of the tire and to prevent tilting of the stud to reduce heating and aging of tread rubber." (see page 15 of the Office Action.) Applicant agrees that Ostrovskis provides motivation to use non-rounds studs to realize certain benefits, such as improved braking and traction. However, the stated motivation to combine the references (improved tire performance) has nothing to do with the installation process disclosed by Pettersson. In fact, as discussed above, both Russia and Ostrovskis state that it is essential to use a non-round charging tube (which is not taught or suggested by Pettersson) in order to properly install non-round studs. Since the Office Action has not provided any evidence of a motivation to use the Pettersson installation process to install the non-round studs disclosed in Russia and Ostrovskis, a *prima facie* case of obviousness has not been established. MPEP § 2143.01(I).

Accordingly, for at least the foregoing reasons, the 35 U.S.C. § 103(a) rejection of claims 1-6, 8-22 and 30-41 should be withdrawn.

Rejection of Claims 7, 8, 29 and 30 Under 35 U.S.C. § 103(a)

The Office Action rejects claims 7, 8, 29 and 30 under 35 U.S.C. § 103(a) for alleged obviousness over Pettersson in view of at least one of Ostrovskis and Russia, and further in view of U.S. Patent No. 6,374,886 (“Eromaki”). This rejection is respectfully traversed.

As discussed above, the applied combination of Pettersson and at least one of Ostrovskis and Russia does not render obvious independent claims 1 and 16.

Claims 7 and 8, being directly dependent upon base claim 1, and claims 29 and 30, being directly dependent upon base claim 16, are allowable for at least the same reasons as for the respective base claims, as well as in view of the respective additional features recited in these dependent claims. Therefore, withdrawal of the rejection of claims 7, 8, 29 and 30 for obviousness is respectfully requested.

Rejection of Claims 23-28 Under 35 U.S.C. § 103(a)

The Office action rejects claims 23-28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Pettersson in view of at least one of Ostrovskis and Russia, and further in view of Finland Patent No. 9/65 (“Finland”) or Japanese Patent No. 56-146407 (“Japan”). Applicant respectfully traverses this rejection.

As discussed above, the applied combination of Pettersson, Ostrovskis, and Russia fail to render obvious the subject matter of independent claim 16.

Applicant submits that neither Finland nor Japan provide for the deficiencies of Pettersson, Ostrovskis and Russia. For example, neither Finland nor Japan teach, disclose or suggest an association between the number of jaw fingers and the cross-sectional shape of a non-round anti-skid stud. Also, Finland and Japan do not teach, disclose or suggest rotating a stud from a first stud orientation with respect to a stud center line as the stud is driven through a stud capturing space. Accordingly, the applied combinations of (1) Pettersson, Finland and at least one of Ostrovskis and Russia and (2) Pettersson, Japan and at least one of Ostrovskis and Russia would not have rendered obvious the features recited in claim 16. Claims 23-28, being indirectly dependent upon base claim 16, are allowable for at least the same reasons as for the base claim, as well as for the respective additional features recited in these dependent claims.

Conclusion

Based on the foregoing, Applicant respectfully submits that the claims are drawn to allowable subject matter and that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place this application in better condition for allowance, the Examiner is requested to contact Applicant's representative by telephone.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By _____ /Jeffrey B. Haendler/
Jeffrey B. Haendler
Registration No. 43,652